



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/647,170
Filing Date: September 27, 2000
Applicant: Klaus INDEFREY et al.
Group Art Unit: 2137
Examiner: Paul E. Callahan
Title: ERROR PROTECTED DATA TRANSFER SYSTEM AND METHOD
Attorney Docket: 32860-000108/US

Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Mail Stop Amendment

July 21, 2005

PETITION UNDER 37 C.F.R. §§ 1.144 and 1.181

Sir:

Pursuant to 37 C.F.R. §§ 1.144 1.181, Applicants hereby petition from the final requirement for restriction set forth in the July 15, 2005 Office Action.

I. Statement of Pertinent Facts:

- A. The above-identified application was filed with original claims 1-7.
- B. In a March 1, 2004 non-final Office Action, the Examiner rejected claims 1-7 on various grounds.

C. In a June 1, 2004 Amendment, Applicants cancelled claims 1-7 in favor of new claims 8-15.

D. In a March 21, 2005 non-final Office Action, the Examiner concluded that original claims 1-7 had been **constructively elected** because Applicants has received an action on the merits for the originally presented invention, and because claims 8-15 (newly added via the June 1, 2004 Amendment) are independent or distinct from the invention originally claimed.

E. In an April 21, 2005 Response, which did not include any claim amendments, Applicants requested reconsideration of the Restriction Requirement.

F. In a July 15, 2005 non-final Office Action, the Examiner repeated the Restriction Requirement. The Examiner also indicated that the April 21, 2005 Response was not fully responsive to the March 21, 2005 Office Action. The Examiner set the reply period to run from the mail date of the March 21, 2005 Office Action.

II. Points to be Reviewed:

A. Whether the Restriction Requirement is Proper.

B. Whether the Starting Point of the Reply Period Set in the July 15, 2005 Office Action is Correct.

III. Action Requested and Arguments:

A. Applicants Request Withdrawal of the Restriction Requirement.

The Examiner's Restriction Requirement is incorrect on its face. According to the Examiner, the respective inventions defined by original claims 1-7 and subsequently added claims 8-15 are distinct because claim 8 "**does not read on**" originally presented claim 1.¹ Applicants disagree for several reasons.

First, as pointed out the helpful examination guidelines of the MPEP, restriction "should never be required," where the claims of an application define the same essential

¹ March 21, 2005 Office Action, page 3, lines 8 and 9; and July 15, 2005 Office Action, page 2, lines 15-17.

characteristics of a single disclosed embodiment of an invention.² In the situation at hand, the instant specification discloses an example, non-limiting embodiment of a single invention (and not two separate inventions) to which original claims 1-7 (now canceled) and subsequently added claims 8-15 are directed. Indeed, claims 8-12 substantially correspond to original claims 1-5 and claims 13-15 include the subject matter of claim 12.

Second, Applicants agree with the Examiner that new independent claim 8 “does not read on” original independent claim 1. But this is simply not pertinent to a Restriction Requirement. Otherwise, any amendment (e.g., a change in terminology) would result in a constructive election.

Third, MPEP 806.05 indicates that where two or more related inventions are being claimed, the principal question to be determined in connection with a Restriction Requirement is whether or not the inventions are distinct. This section of the MPEP provides a laundry list of the various pairs of related inventions and for each pair, how distinctness may be shown. The Examiner’s articulated basis for the Restriction Requirement appears to completely gloss over these MPEP guidelines. And without providing any more pertinent information, Applicants cannot more fully traverse the Restriction Requirement.

In this case, claims 8-15 were added to clarify the subject matter regarded as the invention and to address the various issues raised in the March 1, 2004 Office Action. But new claims 8-15 do not constitute a shift to claiming another invention. The Examiner’s assertions to the contrary are simply incorrect.

B. Applicants Request that the Reply Period Run From July 15, 2005.

In the paragraph bridging pages 2 and 3 of the July 15, 2005 Office Action, the Examiner indicates that the reply period runs from mail date of the March 21, 2005 Office Action. Apparently, the Examiner set the Reply Period to run from the mail date of the previous Office Action based on a belief that the April 21, 2005 Response was not fully responsive to the March 21, 2005 Office Action. Applicants disagree.

² MPEP 806.03.

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The only issue raised in the March 21, 2005 Office Action was the alleged constructive election by original presentation. This single issue was squarely addressed by the April 21, 2005 Response. The fact that Applicants disagreed with the Examiner's position does not make the April 21, 2005 Response somehow deficient. The Examiner's assertions to the contrary are simply incorrect.

Furthermore, the Office Action Summary (attached to the July 15, 2005 Office Action) indicates that the Reply Period starts on the mail date of the July 15, 2005 Office Action. In this regard, the Office Action is internally inconsistent.

Applicants do not believe that this Petition requires any government fee. But if this is incorrect, the Commissioner is authorized to charge any required Petition fee to Deposit Account No. 08-0750.

Respectfully submitted,

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